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EXAMINER

ALVAREZ, RAQUEL

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/092,369
Filing Date: March 06, 2002
Appellant(s): STETSON ET AL.

Stephen M. De Klerk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/20/2009 appealing from the Office action mailed 12/22/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 8, 11-14, 16-19, 21-22, 24-26, 31, 33, 35, 37, 45-46, 49-51-56, 58, 60, 72, 74 and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,128,663 hereinafter Thomas) in view of Official Notice.

With respect to claims 1, 8, 11-14, 16, 18-19, 31, 33, 35, 45, 49-50, 54-56, 58, 60, 72, 74, 78-81 Thomas teaches displaying a message in conjunction with an advertisement on a World Wide Web Page (Abstract). Determining an advertisement to be displayed on a World Wide Web page (i.e. page requested)(col. 4, lines 53-65); determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said advertisement (i.e. banner ad)(col. 4, lines 53-65 and col. 8, lines 64-66); determining targeting criteria associated with said message (i.e. banner ad related to the requested page); receiving a request to serve said World Wide Web page and serving said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53 to col. 9, lines 1-9); serving said advertisement for display on said World Wide Web page, tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53-65).

With respect to receiving personal information from a user about the user. Thomas teaches receiving personal information about the user (col. 2, lines 1-24). Thomas is silent as to the information being received from the user. Official Notice is

taken that it is old and well known to receive personal information from the user such as user's name, age and gender when a user fills out an application and the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving personal information from the user in order to allow the user control of his or her information.

With respect to said tailored message being separate from the advertisement. Thomas teaches the user receiving a banner advertisement (tailored message) the banner advertisement (tailored message) being separate from the requested page (advertisement). Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

With respect to claims 21-22, Thomas further teaches tailoring said message based on external information (i.e. receiving demographic information from other sites)(col. 2, lines 64 to col. 3, lines 1-24).

Claim 17 further recites serving a second message when said tailored message is no longer to be displayed. Official Notice is taken that it is old and well known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is

displayed and when the season is over, a default or second message is displayed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included serving a second message when said tailored message is no longer to be displayed in order to allow the customer to always receive or be exposed to a message.

Claims 24-25, 37, 51 further recite that said tailored message is to be displayed proximal to the advertisement. Thomas is silent as to the location of the message in proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

Claim 26 further recites changing a display attribute within said tailored message. Official Notice is taken that changing display attribute within a message such as changing display color or image will bring the user's attention to the message.

Claims 46, 82 further recite serving or determining a default message if said targeting criteria has not been met. Official Notice is taken that it is old and well known to serve default messages when said targeting criteria hasn't been met. For example, default messages or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

(10) Response to Argument

Appellant argues that Thomas doesn't teach the greeting being related to the advertisement. The Examiner disagrees with Appellant because Thomas teaches the requested page being equivalent to the Applicant's advertisement, the claims do not exclude the advertisement from being a requested page. Applicant's claimed tailored message being the banner ad of Thomas which contains a greeting about the user and information about the requested page. Therefore, contrary to Applicant's arguments, Thomas teaches the banner ad or tailored message being related to the page requested and based on the user's demographic information. In Thomas, the banner ad is equivalent to the tailored message in the claims and the requested page is equivalent to the advertisement being claimed. In addition, Thomas teaches on col. 4, lines 60-65, "particular advertising banner (tailored message) that is chosen to be transmitted with the requested page (advertisement) is determined not, randomly, but in accordance with the **demographic identifier**....selecting appropriate **variant of the requested page**" As can be seen by the cited portion of Thomas above, Thomas teaches the message (banner) being based on demographic identifier and appropriate **variant** of the requested page so therefore the tailored message or banner are not chosen randomly but customized based on the **demographic and user interests** (col. 4, lines 1-14) and **variant of the requested page** (advertisement)(col. 4, lines 60-65).

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that Thomas doesn't teach the message being proximal to the advertisement. The Examiner wants to point out that the Examiner had taken official notice that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad. In addition, after careful review Figure 11, shows the requested information (advertisement) being proximal to the banner ad.

With respect to the Official Notices taken pertaining to the following well known facts: 1) That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like; 2) That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad; 3) That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed; 4) That changing display attribute within a message such as changing display color or image will bring the user's attention to the message and customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public. The Examiner has provided examples and motivation of the well known facts and Appellant hasn't provided a proper challenge that would at least cast reasonable doubt that the known facts weren't known prior to Applicant's invention of June 3, 2002.

"to adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b)." MPEP § 2144.03 (C). An adequate traverse must contain adequate information or argument to create on its face, a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. See *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). Since, Applicant hasn't provided such a challenge, the Official Notices are maintained.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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